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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/104,947 06/25/98 FORBORD

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EXAMINER

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WOLFE, J

ART UNIT

PAPER NUMBER

2754

DATE MAILED:

05/20/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/104,947**

Applicant(s)

**FORBORD**

Examiner  
**John H. Wolff**

Group Art Unit  
**2754**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-4 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-4 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2754

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not evident nor understood where independent claim 1 recites novel subject matter and/or a patentable advance. The recitation dealing with; 'discs having a diameter smaller than the diameter of rigid discs ordinarily contained in a disc drive', does not set forth any reasonable basis or support as to how this indicated replacement of discs is achieved, gains patentable significance, nor is the meaning assigned to the term 'smaller' evident. Relative to what 'larger' diameter is the claimed 'smaller' to be compared. Nor is it seen where claim 2 lends unobvious significance by reciting that a standard 3 1/2 disc and disc drive are involved. Both claims are directed to convention subject matter and fail to recite whereto patentable significance is attributed or how it relates to the invention as disclosed.

Art Unit: 2754

Any response hereto, to be complete, should point out which included limitation in the claims deals with an unobvious or meaningful advance over the convention disc drive structure typically found in a large number of commercial units. As a general observation it is noted that a conventional disk drive which contains a disk is also adapted to support a smaller disk - as claimed by applicant.

In claim 3 the limitations including terms like; 'smaller than', 'ordinarily contained', 'standard configuration' and 'greater than' all leave open to conjecture what relative yard-stick provides a reasonable reference for these subjective phrases, the claim provides no positive support for assigning a definite meaning to these open-ended phrases. Claim 4 is rejected as claim 2 as it also refers to a disc drive that accommodates a standard disc, the examiner acknowledges this statement as a general proposition.

All the claims under review fail to set forth where novelty resides and/or that patentable subject matter is at issue.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 2754

5. Claims 1-4 are rejected under 35 U.S.C. 102(a) as being anticipated by applicants prior art Figs. 1-2.

It is inherently evident that the magnetic disc drive as depicted in prior art Figs. 1-2 meets the claim 1 limitation, including the requirement that it is adapted to accommodate 'smaller' discs'. Insofar as the term smaller is understood, it is well known that smaller discs require less space for purposes of accommodation - the claim calls for no more than that. The numerical values included in dependent claim 2 appear to duplicate one another and are shown to be old in this art .

To the extent that the limitations included in claim 3 find positive support within the claimed arrangement they merely recite structure already old and well known. Claim 4 is rejected for reasoning as set forth with respect to claim 2.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster et al (5,841,605) in view of Battu et al (5,808,838).

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Foster discloses a disk drive assembly suitable for use with a regular magnetic disk as well as with a mini-disk (29) in combination with a head actuator (40). The reference is silent as to the present of a 'stack of disks'. The supporting reference to Battu teaches that a disk drive system including a stack of disks is known in this art. It would have been obvious to a person having reasonable skill in this art, at the time the invention was made, to provide for a stack of discs in Foster for that extends the useful capacity between servicing stops, it also amounts to an obvious extension of art shown to be otherwise old in this technology. Claims 1-4 are obvious in view of and unpatentable over the clear teaching and reasonable suggestions which flow from the art as applied.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. .

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John H. Wolf whose telephone number is (703) 308-3215.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

jaw  
May 18, 1999

  
JOHN H. WOLFF  
PRIMARY EXAMINER  
GROUP 2500